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Remarks

This substitute amendment is necessitated by the fact that the Listing of the Claims submitted with the Amendment originally submitted on June 6, 2005, was incomplete in that it did not include an indication that claims 1-26 were canceled.

Applicant thanks the Examiner for kindly extending his representative, Allison Johnson, the courtesy of a teleconference interview on Monday, June 06, 2005. The Examiner indicated that the insertion of the word "sanding" after the word "by" in claims 27 and 35 would overcome the rejection thereof under 35 U.S.C. § 112, first paragraph. The remaining rejections were discussed. No agreement was reached.

Claims 27, 28, 35-40 are pending in the application. Claims 27, 35-38 and 40 have been amended. New claims 41-50 have been added. The amendments to claims 27, 35-38 and 40 have been made for clarity and not for reasons related to patentability. No new matter has been added. Support for the amendments to the claims and the new claims can be found in general throughout Applicant's Specification and in particular, for example, as follows: claims 27 and 35, pages 15-26, claims 41-43, page 8, lines 11-14, claims 44-46, page 8, line 13, claims 47-49, Tables 9 and 10, claim 50, Example 13.

Applicant submits that the amendments to claims 27 and 35 render moot the rejection of claims 27, 28, and 35-40 under 35 U.S.C. § 112, first paragraph, and request that it be withdrawn.

Claims 35-37, 39 and 40 stand rejected under 35 U.S.C. § 102(b) over Williams (U.S. 4,454,267), Struss et al. (U.S. 4,686,253), Patel (U.S. 5,653,797) or Smith et al (U.S. 4,286,995).

Williams discloses a joint compound that includes filler, binder, treated expanded perlite, a non-leveling agent, and a thickening agent.

Struss et al. disclose a joint compound that includes a filler, a binder, a non-leveling and slip providing material, a water retention or thickening agent and expanded perlite particles that have been treated to make them water repellent.

Patel discloses a process for preparing ready-mixed setting-type joint compound that includes calcium sulfate hemihydrate, water, and a set retarding agent.

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Smith et al. disclose a joint compound that includes gypsum crystals formed by the hydration of calcium sulfate to calcium sulfate dihydrate. The crystals can form in the presence of citric acid.

Claim 35 is directed to a method of reducing the quantity of dust generated by a drywall joint compound that includes filler, water, defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, solvent and binder. The method includes adding a sufficient quantity of dust reducing additive to the drywall joint compound to reduce the quantity of dust generated by sanding the hardened drywall joint compound, and the adding occurs subsequent to the filler, water, defoamer, wetting agent, preservative, fungicide, thickener, nonleveling agent, surfactant, solvent and binder being present in the joint compound. Claim 35 is a method claim --not an article claim. The method of claim 35 requires a joint compound that includes specific components to exist, prior to the addition of a dust reducing additive. In other words, the method requires that the recited components be present in the composition before something that constitutes a dust reducing additive is added to the composition. The method thus calls out a particular sequence of addition. Under 35 U.S.C. § 102(b), the subject matter of a claim is anticipated if each and every element set forth in the claim is found in the a single prior art reference. *Verdegaal Bros., Inc., v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). If the reference fails to teach even one limitation of the claimed invention, then the claim is not anticipated under § 102(b). *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574 (Fed. Cir. 1984).

Williams discloses formulating a joint compound. Williams prepares his joint compound by first combining the binder, preservatives and water in a mixing bowl, and then adding a mixture of the dry ingredients (see, e.g., Williams, col. 3, lines 56-65). Filler is one of the dry ingredients. Therefore, since the filler is the last component that is added to the composition other than water, and Williams does not teach adding anything other than water to the composition after adding the mixture that includes filler, it cannot be disputed that Williams fails to teach adding a dust reducing additive to a joint compound that includes a filler. Williams thus fails to teach a required element of claim 35, i.e., adding a dust reducing additive to a joint compound that includes filler, water, defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent,

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surfactant, solvent and binder. Accordingly, the rejection of claim 35 under 35 U.S.C. § 102(b) over Williams is unwarranted and cannot stand. Should this rejection be maintained, Applicant respectfully requests that the next action identify by reference to column and line number the location in Williams of the requisite teaching.

Struss et al. also fail to teach the method of claim 35. Struss et al. do not teach anything about the method by which their joint compound is created. Struss et al. refer to Williams as disclosing the general joint compound formula. As demonstrated above, Williams does not teach the method of claim 35. Struss et al. thus fail to teach a required element of claim 35, i.e., adding a dust reducing additive to a joint compound subsequent to the joint compound including filler, water, defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, solvent and binder. Accordingly, the rejection of claim 35 under 35 U.S.C. § 102(b) over Struss et al. is unwarranted and cannot stand. Should this rejection be maintained, Applicant respectfully requests that the next action identify, by reference to column and line number, the location in Struss et al. of the requisite teaching.

Patel also fails to teach the method of claim 35. Patel does not expressly teach adding a dust reducing additive to a joint compound that includes filler, water, defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, solvent and binder. Patel also does not inherently teach such a method. Patel discloses that an accelerating agent can be added to his joint compound. The Patel accelerating agents are metallic salts such as aluminum sulfate, potassium sulfate, calcium sulfate and iron sulfate. Metallic salts are not dust reducing additives. In addition, the method by which Patel forms his joint compound does not teach the method of claim 35. In particular, Patel discloses preparing the composition of Example III as follows:

The defoamer, Troysan 174/364, Methocel 240s (thickener), latex (Ucar 133), polyvinyl alcohol, flocculent, glycol, and Colloid 231 (retarder) were pre-weighed and then set aside. The pre-weighed amount of flocculent was added to the pre-weighed glycol, followed by mixing for several minutes. Approximately five gallons of water were added, followed by mixing for several minutes.

In a mixing operation (using dust collector apparatus), 160 gallons of water were added to the mixing apparatus while mixing, followed by the addition

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of the defoamer, Colloid 231, and preservatives to the mixer. Mixing was continued for about two minutes.

The following was added to a hog feeder (a hopper having a screw conveyor which carries the materials to the mixer) in the following order: calcium sulfate hemihydrate, mica, methocel 240S (thickener), polyvinyl alcohol, and the clay attagel M8113. The hog feeder and limestone feeding apparatus were started.

After all of the dry ingredients are added to the mixer, stirring was continued for five minutes. The flocculent preblend (described above) was then added, followed by stirring for an additional three minutes. The latex was added followed by stirring for three minutes. Water was then added to achieve the final desired viscosity (between 400 and 700 BU). The product was then transferred to a holding tank.

(Patel, col. 10, lines 22-45).

Thus, Patel discloses that the latex binder is one of the last ingredients to be added to the composition. Claim 35 requires that the dust reducing additive be add to the composition after binder is present in the composition. Therefore, with respect to Patel, the relevant point in time at which to analyze the Patel method is after the binder is present in the composition. The only ingredient added to the Patel composition after the binder has been added is water. Water is not a dust reducing additive. Therefore, Patel fails to teach a required element of claim 35, i.e., adding a dust reducing additive to a joint compound that includes filler, water, defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, solvent and binder. The rejection of claim 35 under 35 U.S.C. § 102(b) over Patel having been overcome, Applicant requests that it be withdrawn.

Smith et al. also fail to teach the method of claim 35. Smith et al. do not teach a joint compound that includes surfactant, which is required by claim 35. Smith et al. also do not teach how their joint compound is prepared. Smith et al. thus fail to teach required elements of the method of claim 35. Accordingly, the rejection of claim 35 under 35 U.S.C. § 102(b) over Smith et al. is unwarranted and cannot stand. Should this rejection be maintained, Applicant respectfully requests that the next action identify, by reference to column and line number, the location in Smith et al. of the requisite teaching.

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Claims 27, 28 and 38 stand rejected under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 over Williams, Struss et al., Patel or Smith et al.

The descriptions of Williams, Struss et al., Patel and Smith et al. set forth above are incorporated herein.

Claim 27 is directed to a method of reducing the quantity of dust generated by a drywall joint compound, where the method includes providing a drywall joint compound that includes filler, water, and a binder at least one of a defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, and solvent, and subsequently adding a sufficient quantity of dust reducing additive to the drywall joint compound to reduce the quantity of dust generated by sanding the hardened drywall joint compound by at least 50 %. Williams prepares his joint compound by first combining binder, preservatives and water in a mixing bowl, and then adding a mixture of the dry ingredients (see, e.g., Williams, col. 3, lines 56-65). The mixture of dry ingredients includes filler. Water is the only ingredient added to the Williams joint compound after the filler is present in the compound. Water is not a dust reducing additive. Therefore, Williams does not inherently teach the method of claim 27.

Williams also does not suggest the method of claim 27. Williams does not suggest adding anything other than water to his composition after it includes filler --let alone a dust reducing additive. Therefore, the skilled artisan would have no reason to add a dust reducing additive to the Williams composition. Accordingly, a *prima facie* case of obviousness of claim 27 over Williams has not been made, and the rejection of claim 27 under 35 U.S.C. § 102(b) or § 103 over Williams cannot stand. Should this rejection be maintained, Applicant respectfully requests that the next action identify, by reference to column and line number, the location in Williams of the requisite suggestion for modifying Williams.

Struss et al. also fail to teach the method of claim 27. Struss et al. do not expressly teach adding a dust reducing additive to a joint compound that includes filler, water, and binder, and at least one of a defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, and solvent. Struss et al. also do not inherently teach such a method. Struss et al. do not teach or suggest adding anything to their existing joint compound in general or adding a dust reducing additive to a joint

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compound that includes filler, water, and at least one of a defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, solvent and binder, in particular. In addition, Struss et al. do not disclose anything about the method by which their joint compound is prepared. Struss et al. do, however, refer to Williams as disclosing the general joint compound formula. As demonstrated above, Williams does not teach or suggest the method of claim 27. Therefore, Struss et al. fail to teach or suggest the method of claim 27. Accordingly a *prima facie* case of obviousness of claim 27 over Struss et al. has not been established. The rejection of claim 27 under 35 U.S.C. § 102(b) or § 103 over Struss et al. thus is unwarranted and cannot stand. Should this rejection be maintained, Applicant respectfully requests that the next action identify by reference to column and line number the location in Struss et al. of the requisite teaching or suggestion.

Patel also does not teach or suggest the method of claim 27. The only ingredient added to the Patel composition after the binder is present in his composition is water. Water is not a dust reducing additive. Patel also does not suggest adding anything to his joint compound. Therefore, Patel fails to teach or suggest a required element of claim 27, i.e., adding a dust reducing additive to a joint compound that includes filler, water and binder. Accordingly, Applicant submits that the rejection of claim 27 under 35 U.S.C. § 102(b) or § 103 over Patel has been overcome and cannot stand.

Smith et al. also fail to teach or suggest the method of claim 27. Smith et al. do not teach or suggest how their joint compound is prepared. Therefore Smith et al. cannot be found to teach or suggest adding a dust reducing additive to a joint compound that includes filler, water, and binder. The record thus fails to establish a *prima facie* case of obviousness of claim 27 over Smith et al. Accordingly, the rejection of claim 27 under 35 U.S.C. § 102(b) or § 103 over Smith et al. is unwarranted and cannot stand. Should this rejection be maintained, Applicant respectfully requests that the next action identify, by reference to column and line number, the location in Smith et al. of the requisite teaching or suggestion.

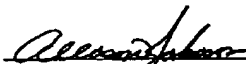
The claims now pending in the application being in condition for allowance, such action is respectfully requested. Should the next action be other than a Notice of Allowance, a teleconference interview is respectfully requested.

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Please charge any additional fees that may be required or credit any overpayment made to Deposit Account No. 501,171.

Respectfully submitted,

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